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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/018,463

04/10/2002

Takeshi Katsuhira

46/160

1777

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7590

06/20/2003

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EXAMINER

HABTE, KAHSAY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/018,463

**Applicant(s)**

KATSUHIRA ET AL.

**Examiner**

Kahsay Habte, Ph. D.

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 (in part) and 6-7 (in part), drawn to tetrazines (**B1 - B4** in formula (I) are all nitrogens) and triazines (three of B1-B4 are nitrogens) and **Het** in formula (I) is diazine (i.e. **Q5 - Q10**).

Group II, claim(s) 1 (in part), 2-5 and 6-7 (in part), drawn to tetrazines (**B1 - B4** in formula (I) are all nitrogens) and triazines (three of B1-B4 are nitrogens) and **Het** in formula (I) is monoazine (i.e. **Q1 - Q4**).

Group III, claim(s) 1 (in part) and 6-7 (in part), drawn to tetrazines (**B1 - B4** in formula (I) are all nitrogens) and triazines (three of B1-B4 are nitrogens) and **Het** in formula (I) is diazoles (i.e. **Q14 - Q19**).

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Group IV, claim(s) 1 (in part) and 6-7 (in part), drawn to tetrazines (**B1 - B4** in formula (I) are all nitrogens) and triazines (three of B1-B4 are nitrogens) and **Het** in formula (I) is oxazole/thiazole (i.e. **Q14 - Q19**).

Group V, claim(s) 1 (in part) and 6-7 (in part), drawn to tetrazines (**B1 - B4** in formula (I) are all nitrogens) and triazines (three of B1-B4 are nitrogens) and **Het** in formula (I) is pyrroles (i.e. **Q11 - Q13**).

Group VI, claim(s) 1 (in part) and 6-7 (in part), drawn to tetrazines (**B1 - B4** in formula (I) are all nitrogens) and triazines (three of B1-B4 are nitrogens) and **Het** in formula (I) is thiophene/furan (i.e. **Q11 - Q13**).

Group VII, claim(s) 1 (in part) and 6-7 (in part), drawn to tetrazines (**B1 - B4** in formula (I) are all nitrogens) and triazines (three of B1-B4 are nitrogens) and **Het** in formula (I) is triazole (i.e. **Q20 - Q22**).

Group VIII, claim(s) 1 (in part) and 6-7 (in part), drawn to tetrazines (**B1 - B4** in formula (I) are all nitrogens) and triazines (three of B1-B4 are nitrogens) and **Het** in formula (I) is oxadiazole/thiadiazole (i.e. **Q20 - Q22**).

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Group IX, claim(s) 1 (in part) and 6-7 (in part), drawn to diazines (two of **B1 - B4** in formula (I) are nitrogens and the rest are carbons) and **Het** in formula (I) is diazine (i.e. **Q5 - Q10**).

Group X, claim(s) 1 (in part), 2-5 and 6-7 (in part), drawn to diazines (two of **B1 - B4** in formula (I) are nitrogens and the rest are carbons) and **Het** in formula (I) is monoazine (i.e. **Q1 - Q4**).

Group XI, claim(s) 1 (in part) and 6-7 (in part), drawn to diazines (two of **B1 - B4** in formula (I) are nitrogens and the rest are carbons) and **Het** in formula (I) is diazoles (i.e. **Q14 - Q19**).

Group XII, claim(s) 1 (in part) and 6-7 (in part), drawn to diazines (two of **B1 - B4** in formula (I) are nitrogens and the rest are carbons) and **Het** in formula (I) is oxazole/thiazole (i.e. **Q14 - Q19**).

Group XIII, claim(s) 1 (in part) and 6-7 (in part), drawn to diazines (two of **B1 - B4** in formula (I) are nitrogens and the rest are carbons) and **Het** in formula (I) is pyrroles (i.e. **Q11 - Q13**).

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Group XIV, claim(s) 1 (in part) and 6-7 (in part), drawn to diazines (two of **B1 - B4** in formula (I) are nitrogens and the rest are carbons) and **Het** in formula (I) is thiophene/furan (i.e. **Q11 - Q13**).

Group XV, claim(s) 1 (in part) and 6-7 (in part), drawn to diazines (two of **B1 - B4** in formula (I) are nitrogens and the rest are carbons) and **Het** in formula (I) is triazole (i.e. **Q20 - Q22**).

Group XVI, claim(s) 1 (in part) and 6-7 (in part), drawn to diazines (two of **B1 - B4** in formula (I) are nitrogens and the rest are carbons) and **Het** in formula (I) is oxadiazole/thiadiazole (i.e. **Q20 - Q22**).

Group XVII, claim(s) 1 (in part) and 6-7 (in part), drawn to monoazines (one of **B1 - B4** in formula (I) is nitrogen and the rest are carbons) and **Het** in formula (I) is diazine (i.e. **Q5 - Q10**).

Group XVIII, claim(s) 1 (in part), 2-5 and 6-7 (in part), drawn to monoazines (one of **B1 - B4** in formula (I) is nitrogen and the rest are carbons) and **Het** in formula (I) is monoazine (i.e. **Q1 - Q4**).

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Group XIX, claim(s) 1 (in part) and 6-7 (in part), drawn to monoazines (one of **B1 - B4** in formula (I) is nitrogen and the rest are carbons) and **Het** in formula (I) is diazoles (i.e. **Q14 - Q19**).

Group XX claim(s) 1 (in part) and 6-7 (in part), drawn to monoazines (one of **B1 - B4** in formula (I) is nitrogen and the rest are carbons) and **Het** in formula (I) is oxazole/thiazole (i.e. **Q14 - Q19**).

Group XXI, claim(s) 1 (in part) and 6-7 (in part), drawn to monoazines (one of **B1 - B4** in formula (I) is nitrogen and the rest are carbons) and **Het** in formula (I) is pyrroles (i.e. **Q11 - Q13**).

Group XXII, claim(s) 1 (in part) and 6-7 (in part), drawn to monoazines (one of **B1 - B4** in formula (I) is nitrogen and the rest are carbons) and **Het** in formula (I) is thiophene/furan (i.e. **Q11 - Q13**).

Group XXIII, claim(s) 1 (in part) and 6-7 (in part), drawn to monoazines (one of **B1 - B4** in formula (I) is nitrogen and the rest are carbons) and **Het** in formula (I) is triazole (i.e. **Q20 - Q22**).

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Group XXIV, claim(s) 1 (in part) and 6-7 (in part), drawn to monoazines (one of **B1 - B4** in formula (I) is nitrogen and the rest are carbons) and **Het** in formula (I) is oxadiazole/thiadiazole (i.e. **Q20 - Q22**).

Group XXV, claim(s) 1 (in part) and 6-7 (in part), drawn to phenyl (**B1 - B4** in formula (I) are all carbons) and **Het** in formula (I) is diazine (i.e. **Q5 - Q10**).

Group XXVI, claim(s) 1 (in part), 2-5 and 6-7 (in part), drawn to phenyl (**B1 - B4** in formula (I) are all carbons) and **Het** in formula (I) is monoazine (i.e. **Q1 - Q4**).

Group XXVII, claim(s) 1 (in part) and 6-7 (in part), drawn to phenyl (**B1 - B4** in formula (I) are all carbons) and **Het** in formula (I) is diazoles (i.e. **Q14 - Q19**).

Group XXVIII, claim(s) 1 (in part) and 6-7 (in part), drawn to phenyl (**B1 - B4** in formula (I) are all carbons) and **Het** in formula (I) is oxazole/thiazole (i.e. **Q14 - Q19**).

Group XXIX, claim(s) 1 (in part) and 6-7 (in part), drawn to phenyl (**B1 - B4** in formula (I) are all carbons) and **Het** in formula (I) is pyrroles (i.e. **Q11 - Q13**).

Group XXX, claim(s) 1 (in part) and 6-7 (in part), drawn to phenyl (**B1 - B4** in formula (I) are all carbons) and **Het** in formula (I) is thiophene/furan (i.e. **Q11 - Q13**).



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Group XXXI, claim(s) 1 (in part) and 6-7 (in part), drawn to phenyl (**B1 - B4** in formula (I) are all carbons) and **Het** in formula (I) is triazole (i.e. **Q20 - Q22**).

Group XXXII, claim(s) 1 (in part) and 6-7 (in part), drawn to phenyl (**B1 - B4** in formula (I) are all carbons) and **Het** in formula (I) is oxadiazole/thiadiazole (i.e. **Q20 - Q22**).

2. The inventions listed as Groups I-XXXII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of each group is the different combinations of rings. The "Het" and right hand side ring with variables B1-B4 have different technical feature. The only common structural feature is two unconnected C-N fragments and not responsible for the overall activity.

3. A telephone call was made to Mr. Paul White on June 18, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicants requested a written restriction requirement.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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**Conclusion**

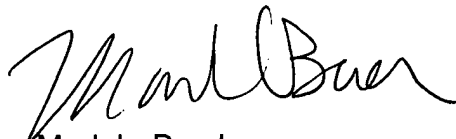
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Kahsay Habte, Ph. D.  
Examiner  
Art Unit 1624



Mark L. Berch  
Primary Examiner  
Art Unit 1624

KH  
June 19, 2003